

2002, with the Notice of Appeal. Applicant requests reconsideration and reexamination of this application in light of the following remarks.

## **REMARKS**

### **I. Status of the Claims**

Claims 1-18 are pending. No claims have been amended or cancelled by this response.

### **II. Rejections Under 35 U.S.C. § 103**

#### ***A. Lagrange and/or Clausen in view of Zviak and Akram.***

Applicant thanks the Examiner for her indication in the Advisory Action that the rejection over Lagrange and/or Clausen in view of Zviak and Akram was overcome by the Reply After Final filed on April 18, 2002.

#### ***B. Lim'438 in view of Akram***

The Office has maintained the rejection of claims 1-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent. No. 6,074,438 ("Lim") in view of U.S. Patent No. 5,230,710 ("Akram") for the reasons set forth in the Advisory Action, and at pages 2-5 of the Final Office Action. Applicant respectfully traverses the rejection for the reasons of record, as well as for the following additional reasons.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *Id.*

The Federal Circuit does not take the requirement for motivation lightly, stating  
“the best defense against the subtle but powerful attraction of a hindsight-based  
obviousness analysis is rigorous application of the requirement for a showing of  
motivation. ...The showing must be clear and particular.” [emphasis added] See *In re*  
*Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (abrogated on other grounds).

In more recent cases, the Federal Circuit has held that determinations of *prima*  
*facie* obviousness must be supported by a finding of “substantial evidence.” See *In re*  
*Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless “substantial evidence”  
found in the record supports the factual determinations central to the issue of  
patentability, the rejection is improper and should be withdrawn. See *Zurko*, 258 F.3d at  
1386.

On January 18, 2002, the Federal Circuit again reaffirmed the Office’s high  
burden to establish a *prima facie* case of obviousness. Specifically, the Federal Circuit  
held that “[t]he factual inquiry whether to combine references must be thorough and  
searching. It must be based on objective evidence of record. This precedent has been  
reinforced in myriad decisions, and cannot be dispensed with.” *In re Sang-Su Lee*, 277  
F.3d 1338, 1343 (Fed. Cir. 2002) (internal quotations and citations omitted).

In the present case, the Office alleges that Lim teaches that both<sup>1</sup> the  
components in the presently claimed composition are suitable for use together,  
particularly in an oxidation dyeing composition. See Final Office Action, p. 4. According  
to the Office, since Lim teaches that the claimed dye bases are compatible, they have

known utility in the same process under the same process conditions. *Id.* Thus, the Office concludes that Lim alone is sufficient to provide a teaching that the two claimed components are useable together in oxidative hair dyeing compositions and processes. *Id.* Additionally, the Office has asserted that Akram narrows the choice of couplers since Akram gives the particular motivation to select 2,6-bis(hydroxyethylamino)toluene from the list of couplers suggested by Lim. See Final Office Action, p. 5.

Even if, for the sake of argument only, all of the Office's above alleged assertions regarding motivation to combine Lim and Akram are true, there still would have been no motivation to choose Applicant's claimed composition comprising at least one oxidation base chosen from a substituted para-aminophenol corresponding to formula (I), and an addition salt thereof with an acid, in combination with 1,3-bis( $\beta$ -hydroxyethyl)amino-2-methylbenzene, and an addition salt thereof with an acid. The Office has failed to provide the requisite "substantial evidence" necessary to show that the combination would have been desirable, and therefore obvious, at the time the invention was made. Instead, the Office improperly alleges the feasibility of the combination as motivation. A similar approach was recently rejected by the Federal Circuit in *Winner Int'l Royalty Corp. V. Wang*. 202 F.3d 1340 (Fed. Cir. 2000).

In *Winner* the Federal Circuit upheld the district court's determination that the claims at issue, directed to an automobile anti-theft device, were not obvious over the prior art. Two key references were at issue, Johnson and Moore. *Id.*, at 1349.

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(...continued)

In discussing the two components of the present claims, the Examiner refers to "the two claimed dye bases." Applicant assumes that the Examiner means the claimed base and the claimed coupler. If not, clarification is requested.

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Johnson disclosed virtually all aspects of the claimed invention, except that Johnson employed a dead bolt mechanism rather than the claimed self-locking ratcheting mechanism. *Id.* Moore disclosed a self-locking ratcheting system. *Id.* The Federal Circuit, finding no suggestion in the references to make the necessary substitution, held that although there was conflicting evidence before the district court on whether one would see the trade-off between using a dead-bolt and using a ratcheting mechanism and conclude that the more secure dead-bolt should be replaced with the more convenient ratcheting mechanism, the district court did not clearly err in finding that one of ordinary skill in the art would not have reasonably elected trading the benefit of security for that of convenience. *Id.* "Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter." *Id.*, [Emphasis added].

In the present case, Applicant's claims recite a composition comprising, *inter alia*, at least one oxidation base chosen from a substituted para-aminophenol corresponding to formula (I), and an addition salt thereof with an acid, and a coupler chosen from 1,3-bis( $\beta$ -hydroxyethyl)amino-2-methylbenzene, and an addition salt thereof with an acid. However, as pointed out previously on the record, Lim merely teaches Applicant's claimed oxidation bases and couplers separately as optional additional ingredients. See Reply After Final, filed April 18, 2002, p 3. Thus, Lim does not teach or suggest the desirability of using the claimed combination of oxidation bases and couplers.

Further, the Office has not provided any suggestion as to what the desirability of using Applicant's claimed combination would have been. Instead, the Office has attempted to prove the feasibility of the combination by asserting that Lim teaches the

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two claimed dye bases are *suitable for use together* and that they are *useable together* in oxidative hair dyeing compositions and processes. As discussed in *Winner*, such assertions of feasibility do not provide the requisite motivation necessary to support a *prima facie* case of obviousness. Rather, the desirability of the combination must be shown.

Further, the addition of Akram to Lim does not provide the missing motivation to choose Applicant's claimed combination of oxidation bases and couplers because Akram does not mention the claimed oxidation bases, but instead merely discusses the claimed couplers. Thus, no substantial evidence of the desirability of using the claimed oxidation base in combination with the claimed coupler has been provided.

Therefore, the motivation relied upon by the Office for the Lim/Akram combination is insufficient. Even if all the Office's allegations regarding Lim and Akram are correct, and it is not admitted that they are, the Office has merely shown that it may have been ***feasible*** to combine the optional ingredients of Lim. Without a further showing of substantial evidence provided on the record that it would have been ***desirable*** to combine the at least one oxidation base chosen from a substituted para-aminophenol corresponding to formula (I), and an addition salt thereof with an acid, with 1,3-bis( $\beta$ -hydroxyethyl)amino-2-methylbenzene, and an addition salt thereof with an acid, the requisite motivation simply does not exist. For at least this reason, the rejection should be withdrawn.

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### **III. Provisional Obviousness-Type Double Patenting Rejections**

The Office has maintained the provisional rejection of claims 1-18 under the judicially created doctrine of obviousness-type double patenting over claims 1-31 of copending Application No. 09/443,142. The Office has additionally maintained the provisional obviousness-type double patenting rejection of claims 1-18 over claims 1-32 of co-pending Application No. 09/443,506. In order to overcome these rejections, Applicant has corrected the typographical mistake in the Terminal Disclaimer filed April 18, 2002, and filed herewith a corrected, executed Terminal Disclaimer, thereby mooting both provisional rejections.

### **IV. Conclusion**

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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